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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/787,119	03/14/2001	Daisuke Yano	80388(47762)	6260

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EDWARDS ANGELL PALMER & DODGE LLP
P.O. BOX 55874
BOSTON, MA 02205

EXAMINER	
RICKMAN, HOLLY C	

ART UNIT	PAPER NUMBER
1794	

MAIL DATE	DELIVERY MODE
01/23/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	09/787,119	YANO ET AL.	
	Examiner	Art Unit	
	Holly Rickman	1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *29 December 2008*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-19* is/are pending in the application.

4a) Of the above claim(s) *6-11 and 17-19* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-5,12-16* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12/29/08 has been entered.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-5 and 12-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. The term "uniform" in claims 1 and 12 is a relative term which renders the claim indefinite. The term "uniform" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. The degree of uniformity required by the term “uniform” is not clear to the examiner. Applicant has argued that the applied prior art is not uniform. However, there does not appear to be any objective standard for determining the degree of uniformity covered by the instant claims. In other words, would a thickness difference

of 1 nm be considered to be uniform? 1 Angstrom? 1 micron? Thus, the metes and bounds of the claimed invention would not be clear to one of ordinary skill in the art.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 1-5 and 12-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kubota et al. (US 4132350) in view of Marechal et al. (US 4899037).

Kubota et al. disclose a magnetic card and transfer tape wherein the magnetic card comprises a base layer structure, a magnetic layer, a masking layer for covering the magnetic layer, a printing layer formed from two different colors of ink having a uniform thickness and a protective layer thereon (see Fig 7; col. 3, line 20 to col. 4, line 27). The transfer sheet is formed from a backing layer 10, a protective layer, a printed layer having printed and non-printed regions of different colors wherein this layer has a uniform thickness 5, a color layer 4 and a magnetic layer 3 bonded to a layer 1b1 which corresponds to the claimed adhesive layer (See Fig 14). The reference is silent with respect to the claimed coercivity of the magnetic layer.

Marechal et al. teach that a suitable coercivity for a magnetic coating in a magnetic care structure is 300-600 Oe which reads on the claimed range.

It would have been obvious to one of ordinary skill in the art at the time of invention to choose an optimal coercivity value from within the range of 300-600 Oe taught by Marechal for

use in the magnetic card and transfer tape structures taught by Kubota et al. in order to achieve the desired recording performance.

With regard to the claim limitation requiring a "uniform" thickness of the printed layer, the disclosure and figures in Kubota are relied upon to show that the printed layer taught therein meets the claim limitation requiring that the thickness of the printed layer is "uniform." The examiner notes that the term "uniform" is a broad term. There is no recitation in the claims regarding the particular parameters of uniformity that must be met (for example, a specific limit on the thickness difference between the printed and non-printed regions). Nor is there a definition of the term given in the specification. Thus, "uniform" must be assigned the broadest reasonable interpretation consistent with the term's ordinary meaning.

The examiner maintains that one of ordinary skill in the art would view the printing layer taught by Kubota having patterned and non-patterned layers deposited therein as being "uniform" in the absence of evidence to the contrary. Given the written disclosure and figures of Kubota et al. , one of ordinary skill in the art would interpret the printing layer taught therein having both the patterned portions and nonpatterned portions (see Fig 5 for example) as being "uniform."

The examiner notes that Fig. 5 shows the particular configuration wherein the patterned printed portion 5a is adjacent to non-patterned portion 5b but that Figures 6-8 and 12-14 do not distinctly point out portions 5a and 5b. It is the examiner's contention that given the two disclosed possibilities of having a printed layer 5 with a portion 5b corresponding to a nonpatterned layer or a printed layer 5 with only patterned regions separated by regions without the presence of any layer at all, it would have been well within the purview of one of ordinary

skill in the art to apply these two possibilities to all of the embodiments of the invention disclosed and illustrated by Kubota et al.

Response to Arguments

7. Applicant's arguments filed 12/29/08 have been fully considered but they are not persuasive.

Applicant argues that Kubota et al. does not consider occurrences of output variations in reproduced output. Applicant maintains that this *is* a feature considered by the present invention. The mere fact that applicant's considered different properties in the preparation of their invention does not patentably distinguish over the applied prior art to Kubota. The examiner suggests that applicant consider presenting *evidence of unexpected results* in output performance associated with the claimed invention if this is where Applicant believes a patentable distinction over Kubota lies.

Applicant further asserts that the structure shown in Fig 5 of Kubota does not correspond to the transferable magnetic tape or the magnetic card of the claimed inventions. Applicant notes that "[t]here is no correspondence relationship between the region at which the patterns are formed and the region at which the magnetic recording layer is embedded." It is not clear to the examiner where the claims require this feature. Clarification is requested describing the particular claim limitation at issue.

Applicant maintains that the structure shown in Fig 5 is formed by previously embedding a recording layer in the covering layer and for this reason, "the formation of the color layer, printed layer, and protective layer does not basically affect the shape of the magnetic recording

layer." Again, it is not clear to the examiner where the claims require that the formation of these layers affect the "shape of the magnetic recording layer." The examiner notes that the claims merely require a "tape." The size and shape of the tape are not specified; nor is the manner in which the tape is made. In any case, the examiner notes that Figures 6-7 and 13-14 also read on the present claims.

With regard to Fig 13, Applicant argues that the medium shown therein is not in the form of a tape. The examiner respectfully disagrees with this assertion and again notes that the claims require a "tape" but do not require any specific dimensions of said tape.

With regard to the term "uniform" as it applies to the prior art, the examiner contends that "uniform" is a broad term. There is a great deal of latitude in interpreting this claim limitation in the absence of a definition in the specification or limitations on the degree of uniformity applicant is seeking claim protection for. Thus, a 112 second paragraph rejection of this claim has been set forth in order to clarify the record with regard to the metes and bounds of this claim limitation. The examiner suggests that applicant consider amending the claims to clarify what thicknesses of the pattern printed region and filling layer region would fall within the scope of "uniform" *if there is support for such a distinction in the original disclosure.*

As for the reliance on Fig 5 to illustrate uniformity, the examiner notes that this Figure is not being relied upon for a quantitative example of some specific level of uniformity but rather as a qualitative example that the reference clearly describes the use of a printed layer having a patterned portion 5a adjacent to a non-patterned portion 5b that would be reasonably considered to be "uniform" by one of ordinary skill in the art. This particular embodiment reads on the

claimed printed layer which is uniform because the empty spaces between portions 5a are filled in with a layer correponding to the claimed filling layer.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to /Holly Rickman/ whose telephone number is (571) 272-1514. The examiner can normally be reached on Monday-Friday 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on (571) 272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Holly Rickman/
Primary Examiner
Art Unit 1794